



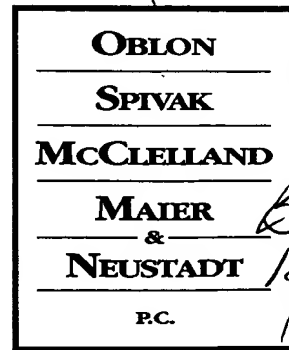
RECEIVED

OCT 28 2002

Docket No.: 201180US3

TC 1700 MAIL ROOM

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231



ATTORNEYS AT LAW

GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM

ROBERT T. POUS
(703) 413-3000
RPOUS@OBLON.COM

RE: Application Serial No.: 09/742,423

Applicants: Kousaku MATSUNO, et al.

Filing Date: December 22, 2000

For: SUBSTRATE TREATMENT PROCESS AND
APPARATUS

Group Art Unit: 1746

Examiner: KORNAKOV, M

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of 0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier

Registration No. 25,599

Robert T. Pous

Registration No. 29,099



22850

(703) 413-3000 (phone)

(703) 413-2220 (fax)

I:\USER\SIIZA\20s\201180\REST_CVR.DOC



201180US3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Kousaku MATSUNO, et al.

SERIAL NO: 09/742,423

FILED: DECEMBER 22, 2000

FOR: SUBSTRATE TREATMENT PROCESS
AND APPARATUS

:

: EXAMINER: KORNAKOV, M

:

: GROUP: 1746

RECEIVED
OCT 28 2002
TC 1100 MAIL ROOM

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Restriction Requirement stated in the Official Action dated September 26, 2002, Applicants provisionally elect Group (Invention) I, Claims 1 and 3-20, drawn to a substrate/semiconductor treatment process, classified in class 134, subclass 26.

Applicants respectfully traverse the outstanding Restriction Requirement for several reasons.

First, the outstanding Office Action asserts that "[t]he inventions are distinct, each from the other" under MPEP § 806.05(d) and § 806.05(e), because regarding Groups I and II, "Group I has another separate utility, such as surface modification or pickling with acidic solution, which is performed as a separate step after pre-cleaning the said surface with ozonated water," because regarding Groups I and III, "the claimed process can be practiced by submerging substrate into the processing liquid in a treatment tank, wherein the rotation means for rotating substrate and nozzle means are not required" while "the apparatus as

claimed can be utilized for coating, which is materially different from the claimed process," and because regarding Groups II and III, "the claimed process can be practiced by submerging substrate into the processing liquid in a treatment tank, wherein the rotation means for rotating substrate and nozzle means are not required" while " the apparatus as claimed can be utilized for coating, which is materially different from the claimed process." However, without further information, such findings lack grounds upon which it can be evaluated whether in fact these propositions are "separately usable" under MPEP §806.05(d) or "materially different" under MPEP §806.05(e). Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP § 803 states the following:

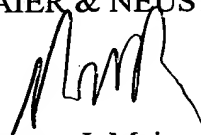
If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In the present application, Claims 1 and 2 are directed to a substrate treatment process for removing organic matter existing on a substrate, while Claim 21 is directed to a substrate treatment apparatus for a substrate, and according to the Office Action, all the claims are classified in the same class. Hence, it appears that these claims in the present application are part of an overlapping search area and that a search for Claims 1 and 3-20 would necessarily include the subclasses required for searches directed to Claims 2 and 21-23 as well. It is therefore believed that there is no undue burden on the Examiner to search all the claims under MPEP § 803, and Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-23 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No: 25,599
Robert T. Pous
Registration No: 29,099
Attorneys of Record



22850

Tel: (703) 413-3000
Fax: (703) 413-2220
GJM/RTP/AY:si
I:\ATTY\AKY20s\201180\rest.wpd